

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper **15**

Filed by: Trial Section Merits Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Filed
12 March 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ALBERT FAZIO,

Junior Party,
(Patent 5,742,543),

v.

ELIYAHOU HARARI,

Senior Party,
(Application 09/280,036).

MAILED

MAR 12 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patent Interference No. 104,493

Before LEE, GARDNER-LANE and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

JUDGMENT PURSUANT TO 37 CFR § 1.622

A telephone conference call was held on March 7, 2002, at approximately 1:30 p.m. (EST), involving:

1. Sally Medley, Administrative Patent Judge.
2. Mr. Parsons, Esq., counsel for Harari.
3. Mr. Brigham, Esq., counsel for Harari.
4. Mr. Taylor, Esq., counsel for Fazio.

5. Ms. Shamilov, Esq., counsel for Fazio.

Fazio filed a reissue application of its involved U.S. patent 5,742,543 on February 21, 2001. Along with the reissue application, Fazio filed an amendment, amending Fazio's only involved claims 17 and 18. During a conference call held on March 1, 2002, counsel for the respective parties were not in agreement that the amended claims 17 and 18 of the reissue application were separately patentable from the count (Paper 15).

During the March 7, 2002 conference call, counsel for Fazio indicated that he will file an amendment to Fazio's reissue application of its involved 5,742,543 patent, amending its claims 17 and 18. A copy of the amendment has been filed in the interference (Paper 16). Counsel for the respective parties agree that the Fazio claims 17 and 18 twice amended are separately patentable from the count. Thus, Fazio no longer has a claim that corresponds to the count in its reissue application.

As provided in the Rules governing entry of adverse judgment, if a patentee involved in an interference files an application for reissue during the interference and the reissue application does not include a claim that corresponds to a count, judgment may be entered against the patentee. 37 CFR § 1.662(b). In light of the above, counsel for the respective parties agree that adverse judgment against Fazio is appropriate.

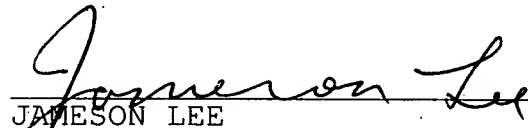
Accordingly, it is

ORDERED that judgment as to Count 1 (Paper 1 at 5) is awarded against junior party ALBERT FAZIO.

FURTHER ORDERED that junior party ALBERT FAZIO is not entitled to a patent containing claims 17 and 18 (corresponding to Count 1) of U.S. Patent 5,742,543.

FURTHER ORDERED that a copy of this paper shall be made of record in the files of application 09/280,036, U.S. Patent 5,742,543, and Fazio reissue application of its 5,742,543 patent¹.

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.


JAMESON LEE)
Administrative Patent Judge)


SALLY GARDNER-LANE)
Administrative Patent Judge)


SALLY C. MEDLEY)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

¹ The reissue application has not yet been given a number.

cc (via federal express and facsimile):

Attorney for Fazio:

Edwin H. Taylor
Blakely Sokoloff Taylor & Zafman LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085
Tel: 408-720-8300
Fax: 408-720-8383

Attorney for Harari:

Gerald P. Parsons
Skjerven, Morrill, MacPherson, LLP
Three Embarcadero Center, Suite 2800
San Francisco, CA 94111
Tel: 415-217-6000
Fax: 415-434-0646